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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,240	02/20/2001	Matthew Thomas Hart	NAIIP445-00.174.01	4408
97298	7590	10/06/2011		
Patent Capital Group 2816 Lago Vista Lane Rockwall, TX 75032			EXAMINER CHOUDHURY, AZIZUL Q	
			ART UNIT 2453	PAPER NUMBER
			NOTIFICATION DATE 10/06/2011	DELIVERY MODE ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTHEW THOMAS HART

Appeal 2009-014206
Application 09/785,240
Technology Center 2400

Before ALLEN R. MacDONALD, ERIC S. FRAHM, and
MICHAEL R. ZECHER, *Administrative Patent Judges*.

FRAHM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 9-11, 21-23, 33-35, and 37-43. Claims 1-8, 12-20, 24-32, and 36 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse. We also enter new ground of rejection under 37 C.F.R. § 41.50(b).

Exemplary Claim

Exemplary independent claim 9 under appeal, with emphasis added to the disputed portion at issue, reads as follows:

9. A computer program product comprising a computer program operable to control a computer to process received e-mail messages, said computer program comprising:

(i) e-mail filtering logic operable to receive an e-mail message and to apply at least one test to identify a received e-mail message as a potentially unwanted e-mail message; and

(ii) message forwarding logic operable to *forward said potentially unwanted e-mail message to its addressee together with a prompt for said addressee to provide feedback as to whether or not said received e-mail message is an unwanted e-mail message;*

wherein a rule associated with said e-mail filtering logic is added if a threshold of a predetermined number of votes positively identifies said potentially unwanted e-mail message as an unwanted e-mail message;

wherein said e-mail filtering logic uses a scoring algorithm responsive to identification of predetermined words within said received e-mail message and a message size of said

received e-mail message to identify said received e-mail message as a potentially unwanted e-mail message.

Examiner's Rejection

The Examiner rejected claims 9-11, 21-23, 33-35, and 37-43 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Pollack (US 6,546,390 B1) and Dieterman (US 6,393,464 B1).

Examiner's Findings

The Examiner determines that Pollack discloses the invention recited in claims 9, 21, and 33 on appeal including a response from a user, but does not disclose a prompt that is sent to the user with potentially unwanted e-mail (Ans. 3-4). The Examiner relies upon Dieterman as disclosing prompting an administrator for approval of potentially unwanted e-mail messages (Ans. 4-5 (citing col. 5, ll. 24-46)). The Examiner interprets the administrator as being the addressee recited in the claims (*see* Ans. 13).

Appellant's Contentions

Appellant presents numerous arguments as to why the Examiner has erred (*see* App. Br. 10-19; Reply Br. 2-18). We will focus our discussion below on the dispositive issue.

Appellant contends that the Examiner erred in rejecting claims 9-11, 21-23, 33-35, and 37-43 under § 103(a) because Dieterman fails to teach forwarding potentially unwanted e-mail messages to the addressee together with a prompt for the addressee to provide feedback as to whether or not the e-mail message is an unwanted message, as set forth in independent claims 9, 21, and 33 (App. Br. 10-11; Reply Br. 2-4). Appellant also contends that “Dieterman clearly distinguishes between the user and the administrator,”

and that it is not reasonable to interpret the administrator as being the addressee (Reply Br. 4).

ISSUE

Based on Appellant's arguments specifically listed above (*see* App. Br. 10-11; Reply Br. 2-4), the issue presented is: Did the Examiner err in rejecting claims 9-11, 21-23, 33-35, and 37-43 under 35 U.S.C. § 103(a) because Dieterman fails to teach or suggest forwarding "said potentially unwanted e-mail message to its addressee together with a prompt for said addressee to provide feedback as to whether or not said received e-mail message is an unwanted e-mail message," as recited in each of independent claims 9, 21, and 33?¹

ANALYSIS

We have reviewed Appellant's arguments in the briefs and we concur with Appellant's conclusion that the Examiner erred in finding that Dieterman fails teach or suggest forwarding "said potentially unwanted e-mail message to its addressee together with a prompt for said addressee to provide feedback as to whether or not said received e-mail message is an unwanted e-mail message," as recited in each of independent claims 9, 21, and 33. We agree with Appellant's above specifically cited contentions regarding Dieterman.

¹ We recognize that Appellant's arguments present additional issues. Many of the arguments presented by the additional issues are not persuasive; nonetheless we were persuaded of error by this issue and as such we do not reach the additional issues as this issue is dispositive of the appeal.

Dieterman describes the disclosed invention in the following manner:

The present invention comprises a method for controlling the delivery of electronic messages sent to and sent by a user. The user's communications can be controlled by an administrator. *The user referred to in the embodiment illustrated will generally be a child with the administrator commonly being the child's parent or guardian.*

(Dieterman, col. 1, ll. 62-67 (emphasis added)). Dieterman's description of Figure 5 found at column 5, lines 23-46, the method by which a user (the child) receives messages, includes steps 57-60 which are followed when a sender is not from the allowed list and administrator approval is needed before passing the message on to the user's inbox. When it is determined that approval is needed at step 57, the message is placed in the *administrator's* inbox at step 58 (col. 5, ll. 37-40). Then, the "administrator thereafter may approve each such message" at step 59 (col. 5, ll. 40-41).

In light of our findings with regard to Dieterman, we cannot agree with the Examiner that "it is reasonable to interpret the administrator as being an addressee," and that "the email to be judged could be addressed to the administrator (addressee) and the administrator (addressee) hence has the opportunity to determine if the email is wanted or unwanted" (Ans. 13). One of ordinary skill in the art could only reasonably understand Dieterman's user to be a child, and thus the addressee, and the administrator to be a parent or guardian, and thus someone other than the addressee.

In view of the foregoing, Dieterman fails teach or suggest forwarding "said potentially unwanted e-mail message to its addressee together with a prompt for said addressee to provide feedback as to whether or not said

received e-mail message is an unwanted e-mail message,” as recited in each of independent claims 9, 21, and 33.

CONCLUSION

The Examiner erred in rejecting claims 9-11, 21-23, 33-35, and 37-43 as being unpatentable under 35 U.S.C. § 103(a).

NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b)

Under 37 C.F.R. § 41.50(b), we enter a new ground of rejection under 35 U.S.C. § 101 for claims 9-11 and 37-43.

Claims 9-11 and 37-43 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Under the Patent Act of 1952, subject matter patentability is a threshold requirement. “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C § 101.

In *Nuijten*, our reviewing court emphasized that:

A transitory, propagating signal like Nuijten’s is not a “process, machine, manufacture, or composition of matter.” Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.

In re Nuijten, 500 F.3d 1346, 1357 (Fed. Cir. 2007). Subsequent to the court's decision in *Nuijten*, the USPTO has issued additional guidance.² Specifically, the USPTO guidance states:

The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals per se, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following approach. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by

² 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010); *Subject Matter Eligibility of Computer Readable Media*.

adding the limitation "non-transitory" to the claim. Cf. *Animals - Patentability*, 1077 Off. Gaz. Pat. Office 24 (April 21, 1987) (suggesting that applicants add the limitation "non-human" to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101).

Independent claim 9 recites “[a] computer program product comprising a computer program.” Appellant’s Specification (*see* first and second full paragraphs at Spec. 9) discloses that computer programs may be “retrieved via the network interface circuit 220 from a remote source” (Spec. 9:11) and the computer program product may be “downloaded via the network interface circuit 220” (Spec. 9:18). Thus, Appellant’s Specification leaves open the possibility that claim 9 covers computer program products consisting of forms of transitory propagating signals, not just storage devices like a RAM, ROM, or HDD. Transitory signals or carrier waves that are downloaded from a remote source are unpatentable under § 101. *Nuijten*, 500 F.3d at 1357.

In view of the foregoing, claim 9 and claims 10, 11, and 37-43 depending therefrom, encompass both statutory and non-statutory subject matter, and claims 9-11 and 37-43 are therefore ineligible under § 101.

DECISION

The Examiner’s rejection of claims 9-11, 21-23, 33-35, and 37-43 is reversed.

We have also entered new ground of rejection under 37 C.F.R. § 41.50(b) for claims 9-11 and 37-43.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection . . . shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

msc